

## REMARKS

The issues outstanding in the Office Action mailed May 6, 2003, are the requirement for restriction, the objections to the claims and the rejections under 35 U.S.C. §102 and §103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

### Requirement for Restriction

Applicants hereby confirm the election of group I, claims 1-12, drawn to glass compositions. The requirement for restriction is respectfully traversed.

First, with respect to method of making claims 19-22, it is submitted that the methods making the glass composition of the claims of group I should be rejoined, at such time as allowable subject matter is found in the elected group. See *In re Brouwer*, 27 U.S.P.Q.2d 1663 (Fed. Cir. 1996), and *In re Ochiai*, 27 U.S.P.Q.2d 1127 (Fed. Cir. 1995).

Next, with respect to the claims of group III, claims 13-18 and 23-25, drawn to various optical components, it is submitted that these claims are related as combination to subcombination. Specifically, the combination optical component claims *require* all of the features of the glass claims of group I, inasmuch as they are *dependent* thereon. In such a situation where claims are related as a combination to subcombination, as here, the MPEP states that *two-way* distinctness *must* be shown. See MPEP §803. Such distinctness has not, and cannot be shown, inasmuch as the optical component claims require the claimed compositions of group I, and cannot be used with other compositions. Thus, it is submitted that insufficient basis exists for separation of this group.

It is understood that the claims have not been restriction *by the Examiner* on the basis of being related as combination/subcombination. However, such *is* their relationship, as quite evident from the above discussion, and the MPEP clearly states that, "where plural inventions are capable of being viewed as related in two ways, *both* applicable criteria for distinctness must be demonstrated to support a restriction requirement. See MPEP §803. (Emphasis added.) Thus, it is submitted that insufficient basis exists to support the restriction requirement as it separates group III from group I.

Finally, with respect to claims in group IV, claims 26-28 drawn to a demultiplexing method, it is submitted that these claims are *also* related to the claims of Group I (and, for that matter, group III) as combination to subcombination, inasmuch as the methods of demultiplexing *require* an optical component of group III. Thus, again, two-way distinctness must be shown, yet such distinctness cannot be shown. It is respectfully submitted that the restriction requirement should be withdrawn in its entirety.

#### Claim Objections

The Examiner is thanked for pointing out various typographical errors in the claims. Appropriate amendments have been made which do not change the scope of the claims either literally or for purposes of the doctrine of equivalents.

#### Rejections Under 35 U.S.C. §102

Claims 1-12 have been rejected under 35 U.S.C. §102 over Yoshii '975; claims 1-6 have been rejected under 35 U.S.C. §102 over Nakashima (JP '318); claims 1-6 have been rejected under 35 U.S.C. §102 over Maeda '304; claims 9-12 have been rejected under 35 U.S.C. §102 over Yoshii '186 and claims 5 and 6 have been rejected under 35 U.S.C. §102 over Menneman '161. Reconsideration of each of these rejections is respectfully requested.

All of the above cited references, with the exception of Menneman, discussed separately below, *require* magnesium oxide. See col. 2, line 5 of Yoshii, col. 2, lines 45-56 of Nakashima, col. 6, lines 59-end of Maeda, and page 1, col. 2, paragraph 14 of the Yoshii application. Thus, these disclosures all fail to anticipate the present claims, which have been clarified to indicate that no magnesium oxide is present. Thus, each of these anticipation rejections should be withdrawn.

With respect to Menneman, while patentees broadly disclose, in their overall compositional ranges, an amount of "0 to 15" % by weight of magnesium oxide, it is submitted that these broad disclosures, which would require a great deal of selection therefrom in order to result in a composition within the scope of the present claims, fall far short of anticipating the present claims. Indeed, the broad disclosures of Menneman present a nearly infinite number of

combinations, many of which fall outside of the scope of the present claims. Thus, this disclosure falls far short of the limited genus containing a significantly small number of species which would be able to anticipate a claim. See, for example, *In re Petering*, 1301 F.2d 676, 133 USPQ 275 (CCPA 1962) or *In re Ruschig*, 379 F.2d 990, 154 USPQ 118 (CCPA 1967). Thus, it is submitted that the rejection under 35 U.S.C. §102 be over this patent should also be withdrawn.

Rejection Under 35 U.S.C. §103

Claims 1-4 and 7-12 have also been rejected under 35 U.S.C. §103 over Menneman '161. Reconsideration of this rejection is also respectfully requested.

At the outset, it is noted that the "anticipatory" examples relied on at page 10 of the Office Action, in fact, no longer anticipate the present claims. It is not seen that it would be obvious for one of ordinary skill in the art to delete magnesium from these examples, particularly, since *all* of the 19 examples of the patent employ magnesium. Moreover, with respect to claims 9-12, Menneman fails to suggest the overall amount of gadolinium, lanthanum and yttrium oxides. Thus, it is submitted that the patent falls far short of suggesting the present claims, and withdrawal of this rejection is also respectfully requested.

The claims of the application are submitted to be in condition for allowance. However, should the Examiner have any questions or comments, she is cordially invited to telephone the undersigned at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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